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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/313,278
Filing Date: May 18, 1999
Appellant(s): GOLDENBERG, DAVID M.

Paul M. Booth, Ph.D.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 25, 2006 appealing from the Office action
mailed January 9, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is generally correct. It is noted that this section of appellant's brief includes arguments pertaining to the statutory rejection. Arguments presented in this section of the brief are considered to be moot.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

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(A) U.S. Patent 6,039,688 to Douglas et al., published March 21, 2000, filed October 31, 1997

(B) Official Notice—See Examiner's Discussion for claim 51.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Douglas et al. (U.S. Patent 6,039,688).

Claim 39: FIG. 1 illustrates a patient and a physician connected to a system interface (18). Any communication made by the physician or patient to the system interface is considered an inquiry from a user. The physician and patient can access different services, with each service being considered a "level of service".

(I) First level of service: Col. 14, lines 38-52 describe a first level of service. The "user sophistication" in this case is the number of points that the user earns for participating in the system. The system thus determines the user sophistication by keeping a record of the points for each user. This correlates to the sliding point scale discussed in the specification used for determining user sophistication (pages 11, lines 1-3 of appellant's specification). The searching of the database in this case is the searching of the record in the computer system containing

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user's number of accumulated points and identifying the accumulated points. The results of the search are delivered to the user by allowing the user to view the information (col. 14, line 40).

Claim 40: (II) Second level of service: Col. 16, lines 21-55 describe a second level of service, in which searches are made on the database (computer system) in order to locate "more information", such as a list of articles and internet sites. (III) Third level of service: FIG. 48 illustrates a third level of service in which a user (Fred) is provided with a list of healthcare professionals (Susan). The user (Fred) is referred to the health professional (Susan) via the on-line conferencing arrangement of FIG. 48. (IV) Fourth level of service: Col. 17, lines 51-60 outline a fourth level of service in which the physiological condition (vital signs, blood pressure, weight) are monitored. Col. 6, lines 7-13 outline the administration of treatment by ordering that the patient take certain medications or participate in support groups.

Claims 41-43: The method steps defined by Douglas et al. meet each of parts (A), (B) and (C) defined in claim 40.

Claim 44: The levels of service may be accessed in any order. For example, the user can perform a search of articles and Internet sites (Second Level) before having an on-line meeting with health professional (Third Level of Service). After a given period of time, the user can take recommended medications or participate in support groups (Fourth Level of Service), such as the next day after meeting with the health professional.

Claims 45-47: The method steps defined by Douglas et al. meet each of parts (B) and (C) as defined in claim 40.

Claim 48: FIG. 57 of Douglas et al. illustrates a utilization review system. The user preference is the norm established for the percentage of patients which are desired to be using the

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system (The listed norm is 17.3%). The weighing function is the measurement of each physician's percentage of patients who participate in the program. The physicians are thus ranked by the percentage of the patients under their supervision who participate in the program. The selection of the user is the designation of which physicians are on the list shown in FIG. 57.

Claim 49: The method of Douglas et al. includes step (C) from claim 40.

Claim 50: As described at col. 6, line 7-13, the user can be instructed via the system to take a medication. These are the telemedicine signals sent to the patient. The implanted device is thus whatever drug the user is asked to take and which releases chemicals into the body.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. in view of Official Notice.

Claim 51: Within the system of Douglas et al., the user can be asked remotely to take medication, but is not asked to undergo surgery. However, Examiner takes Official Notice that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician - patient interaction. It would therefore have been obvious to one of ordinary skill in the art to modify Douglas et al. to include a recommendation to the remote patient that the patient undergo surgery so as to improve the patient's health and prevent or eliminate disease as is well known in the art.

(10) Response to Argument

Claims 39-50:

Claims 39-50 are grouped together for purposes of argument. Accordingly, claims 39-50 stand and fall together.

Appellant's arguments for this group are exclusively addressed to the meaning of the term "user sophistication", arguing that Douglas et al. does not provide any teaching of the feature claimed as "user sophistication" (Appellant's arguments at page 6, second paragraph, lines 1-3 of the brief are a summary of this argument).

In determining the meaning of this term, examiner has relied upon teachings of the meaning of this term in the specification, consistent with *Phillips v. AWH Corp.* 75 USPQ2d 321 (CAFC 2005), and MPEP 904.01.

The concept of user sophistication is discussed in general terms within the specification at page 3, lines 12-14 and page 4, line 9. More specific information about how this determination is made is provided in the specification at page 10, lines 31-32 and page 11, lines 1-3. As best as can be determined from appellant's specification, the determination of user sophistication can be made by: (1) determining a user's level of education; or (2) using a sliding scale with numbers, such as the numbers 1-10.

Examiner maintains that Douglas et al. teaches an adjustable point scale in the form of a point counting system, where the user accumulates points (the user actually accumulates "apples") which are recorded by the system (col. 14, lines 38-52). This correlates with the numerical system which appellant describes in the specification for determining user

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sophistication. This manner of interpretation is also consistent with the teachings of *Phillips v. AWH Corp* (“*Intrinsic evidence is the primary source for determining meaning of claim terms, since claims themselves provide substantial guidance as to the meaning of particular terms, since claims are part of, and therefore must be read in view of, specification, which is always highly relevant to claim construction analysis, and is the single best guide to the meaning of disputed terms...* ”).

Examiner further maintains that the actual number of points, or apples, accumulated by the user does in fact correspond to a “user sophistication”. A user who accumulates more points is defined by Douglas et al. as one who has “good participation in the program” (col. 14, line 43) and who accordingly receives more education and training (col. 14, lines 53-57). This matches appellant’s own definition of a sophisticated user at page 7, third paragraph, lines 1-4 in appellant’s brief. Here, appellant gives an example of a sophisticated user as a patient who suffers from epilepsy. The patient is considered to be sophisticated because the patient seeks out and develops knowledge. This matches the behavior of the user in Douglas et al., where the user seeks out and develops knowledge and skills and accumulates reward points as the process progresses.

Examiner maintains that the point system in Douglas et al. does in fact provide an indication of user sophistication, and is consistent with the definitions of this term in the specification and consistent with appellant’s arguments in the record.

Claim 51: Appellant argues that the evidence of Official Notice does not teach the claimed feature of “to perform remote surgery”. Appellant does not dispute the evidence

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presented by Official Notice, but rather, only questions whether it is applicable to the phrase “to perform remote surgery”.

Pursuant to the requirements of *Phillips v. AWH Corp.* cited herein, examiner has turned to appellant’s specification for guidance of the meaning of this term.

The specification provides two different accounts pertaining to the topic of “remote surgery”. The first account appears on page 14, third paragraph, which states:

“As a further example, remote professionals could perform or guide remote surgery using image data...”

The second account appears at page 19, third paragraph, which states:

“Dr. Y of Mount Sinai responds directly to the patient on the special web site link arranged for such consultations, and gives patient Charles a series of questions regarding his past diagnosis and treatment, including the recommendations made by his current urologist for surgery and irradiation...” (emphasis added).

Examiner maintains that these teachings from the specification pertain to the claimed concept of performing remote surgery. The first pertains to a direct, invasive surgical procedure. The second pertains to informing a patient of the need for surgery as part of the process of the surgical process.

Examiner took Official Notice that this second process would have been well known to the skilled artisan, and appellant did not dispute this finding as evidence. Examiner further indicated that this second process will read on the claimed phrase “perform remote surgery”, given the intrinsic evidence from the specification that engaging in such surgery is not purely

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limited to invasive procedures, but can also involve communicating electronically with the remote patient a need for surgery as part of the surgical process.

Contrary to appellant's assertions, the examiner is not suggesting that merely talking with a patient results in *sua sponte* amputation of a limb (page 9, third paragraph of the brief). Such a suggestion is ludicrous, and no such suggestion has been made. Rather, Examiner has asserted that consulting with a patient at a remote location is part of the surgical process, as defined in the specification. Accordingly, it reads upon the claimed features set forth in claim 51.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

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APPEAL CONFERENCE
HELD 3/31/06.
AGREEMENT TO PROCEED
ON APPEAL.